

Appl. No. 09/766,275
Amdt. Dated December 21, 2004
Reply to Office Action of September 22, 2004

• • R E M A R K S / A R G U M E N T S • •

The Official Action of September 22, 2004 has been thoroughly studied. Accordingly, the following remarks are believed to be sufficient to place the application into condition for allowance.

Claims 1-3, 6 and 7 are pending in this application.

Claims 1-3 stand provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-30 of copending Application No. 09/613,814 in view of U.S. Patent No. 5,681,645 to Morman.

Claim 6 stands rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,372,067 to Kobayashi et al.

Claim 6 stands rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,531,014 to Kobayashi et al.

Claims 1-3 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,681,645 to Strack et al. in view of U.S. Patent No. 5,116,662 to Morman.

For the reasons set forth below, it is submitted that each of the pending claims is allowed over the prior art and pending applications relied upon by the Examiner, and therefore each of the outstanding rejections should properly be withdrawn.

Favorable reconsideration by the Examiner is respectfully requested.

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In response to the rejections of claims 1-3 and 6 that are based upon the judicially created doctrine of obviousness-type double patenting, applicants are submitting herewith a Terminal Disclaimer in which the terminal portion of any patent issuing from the present application that would extend beyond the term of any patent issuing from copending Application No. 09/613,814 or U.S. Patent No. 6,372,067 to Kobayashi et al. or U.S. Patent No. 6,531,014 to Kobayashi et al. is disclaimed.

The Terminal Disclaimer is being signed by applicants' attorney of record who is authorized by the common Assignee to execute and submit the Terminal Disclaimer.

On page 3 of the Official Action the Examiner concedes that Strack et al.

...fails to disclose that the propylene homopolymer is present in the amount of greater than 0 to 99% by weight as required by [amended] claim 2.

The Examiner further states that:

Additionally, Strack fails to teach that the component fibers of the sheet having inelastic stretchability comprises ethylene/propylene copolymer containing ethylene at 0.5 - 10% by weight, ethylene/propylene/butane containing ethylene at 0.5 - 10% by weight and butane at 0.5 - 15% by weight, or a mixture thereof at 100 - 10% by weight as required by [new] claim 7.

The Examiner has accordingly relied upon Morman as describing a multi-directional stretch composite elastic material comprising at least one sheet which is stretched and one necked (non-elastic) material, which are joined together in at least three locations.

The Examiner noted that Morman describes that:

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...the non-elastic materials are nonwovens made of polyolefins and similar polymer including ethylene copolymers, propylene copolymers and butene copolymers (column 4, lines 44 – 64).

The Examiner further states that the necked material can also comprise polypropylene and can comprise a mixture of two or more fibers.

The Examiner concludes:

Therefore, in one embodiment, fibers can comprise ethylene/propylene/butene copolymers as one fiber type and polypropylene as another fiber type.

In which case the Examiner notes:

It should be noted that if polypropylene is present in any amount, it will meet Applicant's requirement of greater than 0%.

In combining the teachings of Strack et al. and Morman the Examiner takes the position that:

It would have been obvious...to create the non-elastic textile web of Strack with the copolymer and polypropylene fiber combination of Morman motivated by the desire to improve resilience, stretch and recovery of the composite.

The Examiner concedes that her proposed combination of Strack et al. in view of Morman fails to teach that the inelastic material comprises ethylene/propylene copolymer containing ethylene at 0.5 – 10% by weight, ethylene/propylene/butene containing ethylene at 0.5 – 10% by weight and butene at 0.5 – 15% by weight, or a mixture thereof at 100 -10% by weight.

Nevertheless the Examiner has set forth the following analysis:

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It should be noted that the amount of ethylene or ethylene and butene is a result effective variable. For example, as the amount of ethylene increases, the material possess more characteristics similar to ethylene, etc.

From this reasoning the Examiner concludes:

It would have been obvious....to create the inelastic material comprising ethylene/propylene copolymer containing ethylene at 0.5 – 10% by weight, ethylene/propylene/butene containing ethylene at 0.5 – 10% by weight and butene at 0.5 – 15% by weight, or a mixture thereof at 100 -10% by weight since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

The Examiner has specifically relied upon the holding in *In re Boesch* as supporting this position (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

The Examiner was asked to review the Board of Patent Appeals and Interferences opinion in *Ex parte Roland Barth* (Appeal No. 1998-0982; Application No. 08/399,715) (<http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd980982.pdf>). In *Barth*, the Board cited *Boesch*, noting that the optimization referred to in *Boesch* is the optimization of a known parameter or “effective variable in a known process.” The Board stated that “...in all authorities known to us, the optimization relates to a range or variable.”

In the present situation, the Examiner has taken the position that “the amount of ethylene or ethylene and butene is a result effective variable.”

Specifically the Examiner states that “as the amount of ethylene increases, the material will possess more characteristics similar to ethylene, etc.” (underlining added).

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Morman provides no teaching as to any particular benefit for using ethylene over any other olefin that are taught.

More importantly, Morman does not teach any type of "ethylene" characteristic "etc." that would lead one skilled in the art to follow the Examiner's position.

Adopting the Examiner's position, one could just as well take the position that it would have been obvious to increase the amount of propylene or butylene in order to increase the propylene or butylene "characteristics" or even to decrease the amount of ethylene or propylene or butylenes to decrease the "characteristics" of these components in the resulting material.

There is clearly no guidance for taking the Examiner's position or any position.

Accordingly, it is submitted that there is no basis for establishing "obviousness" as required under 35 U.S.C. §103.

That is, there is no suggestion or motivation within the teachings of Strack et al. or Morman that supports the Examiner's position on obviousness.

The Examiner has merely tried to establish that it would have been obvious to increase ethylene to increase the "characteristics similar to ethylene, etc."

The Examiner's attempt to identify a result effective variable in order to rely upon the teachings of in *In re Boesch* has not been successful.

The Examiner's readjusted position has strayed further from the basic principle that the prior art must provide a suggestion or motivation for combining and modifying the teachings of the prior art. It is that suggestion or motivation which is the essence of "obviousness."

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The Examiner cannot merely isolate one of many components and take the position that it would be obvious to increase that component in order arbitrarily increase the characteristics of that component to the exclusion of others, especially when there is no guidance or teaching to do so.

As conceded by the Examiner, Strack et al. in view of Morman fails to teach that the inelastic material comprises ethylene/propylene copolymer containing ethylene at 0.5 – 10% by weight, ethylene/propylene/butene containing ethylene at 0.5 – 10% by weight and butene at 0.5 – 15% by weight, or a mixture thereof at 100 -10% by weight.

There is no teaching within Strack et al. or Morman to increase the amount of ethylene as the Examiner purports.

It is only the Examiner's unsupported position that it would be obvious to increase ethylene to increase the ethylene characteristics.

Even if the Examiner could point to some teaching in Morman that suggests the proposed increase in ethylene, the Examiner would still have to establish that the teaching were applicable to Strack et al.

Accordingly, the Examiner has not established the requisite obviousness needed to properly combine the teachings of Strack et al. and Morman and reject the claimed invention.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

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It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejections of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

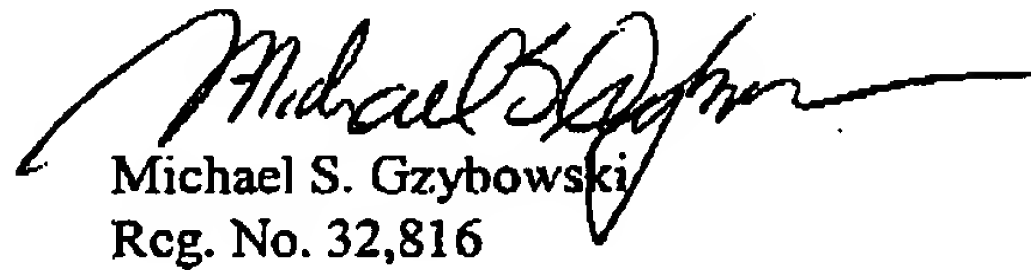
If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

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time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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